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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,510	05/11/2004	Donald R. STEVENSON	47399-0034	3509

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BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP  
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EXAMINER
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ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/09/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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## Office Action Summary

Application No.

10/709,510

Applicant(s)

STEVENSON ET AL.

Examiner

Joseph D. Anthony

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1/11/2007 as RCE and amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-7, 9-14 and 16-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7, 9-14 and 16-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION AFTER FILING OF RCE

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2-3 and 10-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's amendment filed 1/11/07 with the RCE is deemed to introduce New Matter into independent claim 10, because said amendment deleted the requirement that the alkyl bisphenol-A phosphites have to be selected from C<sub>10-15</sub> alkyl bisphenol-A phosphites, and deleted the limitation of where the pentaerythritol phosphites are selected from C<sub>8-15</sub> pentaerythritol phosphites. Nowhere can the examiner find any support in the originally filed specification, claims, drawings or abstract, for where the alkyl bisphenol-A phosphites can be other than those selected from C<sub>10-15</sub> alkyl bisphenol-A phosphites. Likewise, the examiner is unable to find any support in the originally filed specification, claims, drawings or abstract, for where the pentaerythritol phosphites are selected from pentaerythritol phosphites that have R<sup>4</sup> groups outside those taught for formula (VI).

NOTE: In light of applicant's introduction of new matter into independent claim 10, claim 10 along with dependent claims 2-3 and 11-14, are deemed to have an effective filing date of 1/11/07, which is the actually filing date of the amendment that introduced the new matter.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16-20, 24-28, and 33-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 16 and 33 are both deemed to be indefinite in regards to the phrase: "at least two phosphites esters, **and further wherein** a first phosphite ester is . . ." [emphasis added]. If applicant is trying to specify what the "at least two phosphite ester" are selected from, then the existing claim language is very confusing. The examiner suggests that the above phrase, in each of claim 16 and 33, be amended to read: -- at least two phosphites esters wherein the first phosphite ester is . . .--.

Dependent claim 24 is indefinite because the scope of the number of carbon atoms in the R<sup>4</sup> moiety of the pentaerythritol phosphites of formula (VI), is outside independent claim 21, from which claim 24 directly depends, wherein the pentaerythritol phosphites are limited to C<sub>8-15</sub> pentaerythritol phosphites.

Dependent claim 38 is indefinite because the scope of the number of carbon atoms in the R<sup>4</sup> moiety of the pentaerythritol phosphites of formula (VI), is outside of C<sub>8-15</sub> pentaerythritol phosphites as claimed directly above.

Dependent claims 28 and 42 are both indefinite in regards to the phrase: "said phosphite ester is . . .", when the phosphite ester is chosen to be of formula (IX) since esters of formula (IX) are of a single species and independent claims 21 and 33 from which claims 28 and 42 respectfully depend, require that there is "at least two phosphite esters".

The said other claims are being rejected here because they are dependent on rejected base claims.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2-3 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevenson et al. U.S. Patent Number 6,824,711.

Stevenson et al. teach a liquid polymer additive composition comprising at least one phosphite ester selected from the group consisting of aryl phosphites, alkyl phosphites, aryl/alkyl phosphites, bisphenol-A phosphites, dialkylene glycol phosphites and polydialkylene glycol phosphites, pentaerythritol phosphites, p-cumyl phenol

Art Unit: 1714

phosphites and blends thereof and approximately from 50 to 800 ppm inclusive of zinc per 100 parts resin. The stabilizer is used as either a complete or a partial replacement of toxic-metal containing antioxidant stabilizer additives. Applicant's claims are deemed to be clearly anticipated over the disclosure of said patent. Please remember that due to the new matter introduced into claims 2-3 and 10-14 by the amendment filed 1/11/07, the effect filing date of these claims is 1/11/07.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 2-7, 9-14 and 16-42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,824,711. Although the conflicting claims are not identical, they are not

Art Unit: 1714

patentably distinct from each other because there is massive overlap in the claimed subject matter.

### ***Response to Arguments***

9. Applicant's arguments filed 1/11/07 with the amendment and RCE have been fully considered but are not deemed to place the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth next.

The examiner has dropped all the previously made prior-art rejections, as set forth in the Final Rejection, in light of applicant's amendment to independent claims 10, 16, 21 and 33 limiting the claimed composition to those that "consists of" the recited components. There is deemed by the examiner, to be neither a teaching nor a suggestion in the prior-art to make applicant's claimed compositions that positively exclude the other components found within said prior-art compositions.

### ***Prior-Art Cited But Not Applied***

10. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

### ***Examiner Information***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's

Art Unit: 1714

supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



**Joseph D. Anthony**  
**Primary Patent Examiner**  
**Art Unit 1714**

4/2/07